

Applicants: Robert H. DeBellis et al.  
Serial No.: 09/828,413  
Filed: April 6, 2001  
Page 4

#### Remarks

Claims 1, 10 and 14-19 are pending in the subject application. Applicants have hereinabove cancelled claims 14-16 without prejudice or disclaimer to their right to pursue the subject matter of these claims in a later filed application. Applicants have hereinabove amended claim 1. Support for the amendments to claim 1 may be found inter alia in the specification at page 7, line 31 - page 8, line 2. This amendment does not involve any issue of new matter. Therefore, entry of this amendment is respectfully requested such that claims 1, 10 and 17-19 will be pending.

#### Formalities

Applicants acknowledge the Examiner's statement that the rejection over Lawson et al. has been withdrawn.

#### Rejections Under 35 U.S.C. §102(b)

The Examiner rejected claims 1, 10, 14, 15 and 17-19 under 35 U.S.C. §102(b) as allegedly anticipated by Chinowsky. The Examiner stated that the claims are directed to a one step method of treatment of a subject with sickle cell disease comprising administering an amount of an antiviral agent such as acyclovir effective to prevent sickling to treat the sickle cell disease. The Examiner stated that Chinowsky discloses a one step administration of acyclovir in a patient with sickle cell hemoglobin C disease.

In response to the Examiner's rejection, but without conceding

Applicants: Robert H. DeBellis et al.  
Serial No.: 09/828,413  
Filed: April 6, 2001  
Page 5

the correctness thereof, applicants point out that claims 14 and 15 have been cancelled. Thus, the rejection thereof is now moot.

In response to the Examiner's rejection of the remaining claims, applicants respectfully traverse. Nevertheless, without conceding the correctness of the Examiner's rejection but to expedite prosecution of the subject application, applicants have hereinabove amended claim 1. Applicants point out that newly amended claim 1 excludes acyclovir as a claimed antiviral agent. In view of the above remarks, applicants maintain that claims 1, 10 and 17-19 satisfy the requirements of 35 U.S.C. §102(b) and respectfully request that the Examiner reconsider and withdrawn this ground of rejection.

**Rejections Under 35 U.S.C. §102(a)**

The Examiner rejected claims 1, 10, 14 and 17-19 under 35 U.S.C. §102(a) as allegedly anticipated by De Castro et al. The Examiner stated that De Castro et al. disclose the one step method of administering ribavirin to a patient with sickle cell disease. The Examiner stated that because the patient is the same, namely a person afflicted with sickle cell disease, the compound administered is the same, acyclovir or ribavirin and the amount administered falls within the ranges given in the specification on page 7 for an oral dosage as being an effective dose, the result of the treatment must necessarily, inherently be the same. The Examiner stated that it is not relevant to the analysis of the claimed method that the reference makes no mention of inhibiting, preventing, etc. The Examiner stated that discovery of a new benefit for an old

Applicants: Robert H. DeBellis et al.  
Serial No.: 09/828,413  
Filed: April 6, 2001  
Page 6

process does not render the old process patentable.

In response to the Examiner's rejection, but without conceding the correctness thereof, applicants point out that claim 14 has been cancelled. Thus, the rejection thereof is now moot.

In response to the Examiner's rejection of the remaining claims, applicants respectfully traverse. Nevertheless, without conceding the correctness of the Examiner's rejection but to expedite prosecution of the subject application, applicants have hereinabove amended claim 1. Applicants point out that newly amended claim 1 excludes acyclovir and ribavirin as claimed antiviral agents. In view of the above remarks, applicants maintain that claims 1, 10 and 17-19 satisfy the requirements of 35 U.S.C. §102(a) and respectfully request that the Examiner reconsider and withdrawn this ground of rejection.

#### **Claim Objection**

The Examiner objected to claim 16 because it is dependent upon a rejected base claim, but noted that it would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examiner stated that claim 16 is still directed to allowable subject matter. The Examiner stated that inclusion of penciclovir and famciclovir in the method claim would also be directed to allowable subject matter. The Examiner stated that the following claim is allowable:

Applicants: Robert H. DeBellis et al.  
Serial No.: 09/828,413  
Filed: April 6, 2001  
Page 7

1. A method of treating a subject afflicted with sickle cell disease which comprises administering to the subject an amount of an antiviral agent effective to inhibit sickling of a cell in the subject so as to thereby treat the subject, where the antiviral agent is valaciclovir, penciclovir or famciclovir.

In response, applicants respectfully traverse. Nevertheless, without conceding the correctness of the Examiner's rejection but to expedite prosecution of the subject application, applicants point out that claim 16 has been cancelled and that the subject matter thereof has been incorporated into amended claim 1. Thus, applicants contend that the objection of claim 16 is now moot and respectfully request that the Examiner reconsider and withdrawn this ground of objection.

In addition, applicants point out that claim 1 has been amended as suggested above by the Examiner. Therefore, applicants contend that amended claim 1 is now in condition for allowance and respectfully request allowance of claim 1 and claims 10 and 17-19, which depend therefrom.

#### Summary

For the reasons set forth hereinabove, applicants respectfully request that the Examiner reconsider and withdraw the various grounds of rejection and objection and earnestly solicit allowance of pending claims 1, 10 and 17-19.

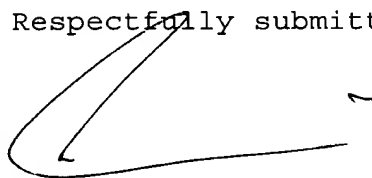
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants'

Applicants: Robert H. DeBellis et al.  
Serial No.: 09/828,413  
Filed: April 6, 2001  
Page 8

undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White  
Registration No. 28,678  
Alan J. Morrison  
Registration No. 37,399  
Attorneys for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
Tel. No. (212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Alan J. Morrison  
Reg. No. 37,399

3/21/01  
Date